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FOX,D — EXAMINER

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ART UNIT	PAPER NUMBER
1804	10

DATE MAILED: 01/28/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 10/28/91 ☑ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~____ days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☑ PTOL-397

Part II SUMMARY OF ACTION

1. ☑ Claims 17-18,20-21,23-25 are pending in the application.
   Of the above, claims ____ are withdrawn from consideration.
2. ☑ Claims 19 have been cancelled.
3. ☐ Claims ____ are allowed.
4. ☑ Claims 17-18,20-21,23-25 are rejected.
5. ☐ Claims ____ are objected to.
6. ☐ Claims ____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ____; filed on ____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1804.

Claims 17-18, 20-21, 23 and 24-25 (newly submitted) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,004,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to genetically transformed cotton plants and seeds, as stated in the last office action for claims 17-21 and 23.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Receipt of Applicant's terminal disclaimer is noted. However, the disclaimer was deemed defective, since the assignee name in the disclaimer does not exactly correspond to the assignee name of record, as outlined on the accompanying PTOL-397.

The rejections of the claims under 35 U.S.C. 112, second and fourth paragraphs, that appeared in the last office action have been withdrawn in view of the amendment filed 28 October 1991.

Claims 24-25 (newly submitted) are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24-25 are indefinite in their recitation in line 5 of "gene cellular product" which is awkward. Claims 24-25 are indefinite in their recitation in line 10 of "protein selection agent", since the usage of "selection agent" to designate a gene product appears contrary to art-recognized definitions. See page 11 of the specification, lines 22-30, where the substance that actually affects susceptible cells is referred to as a "selection agent". See also page 9 of the specification, lines 11-19, which refers to a second foreign gene construct comprising a "selectable marker gene". See also page 13 of the specification, line 35, which refers to a cellular product comprising a "marker enzyme". See also claim 1 of U.S. Patent No. 5,004,863 which refers to a selection agent resistance gene. Claim 25 is indefinite in its recitation in line 12 of "the foreign gene construction" as it is unclear to which foreign gene construction this refers. Claim 25 is indefinite in its recitation in line 13 of "its" as it is unclear whether this refers to the plant or to the gene construction.

The rejection of the claims under 35 U.S.C. 112, first pararagraph, that appeared in the last office action, has been

withdrawn, in view of the arguments in the bottom paragraph of page 6 of the amendment filed 28 October 1991.

Claims 17-18, 20-21, 23 and 24-25 (newly submitted) are deemed free of the prior art, as stated for claims 17-21 and 23 in the last office action.

No claim is allowed.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 24, 1992

David T. Fox
Patent Examiner
Art Unit ~~184~~ 1804
David T. Fox